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EXAMINER

AILES, BENJAMIN A

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/976,630
Filing Date: October 11, 2001
Appellant(s): HAINES, ROBERT E.

James D. Shaurette
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07 January 2008 appealing from the Office action mailed 06 April 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,333,790	KAGEYAMA	12-2001
2002/0198969	ENGEL	12-2002
6,317,570	UCHIDA	11-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21-27 are not limited to tangible embodiments. Regarding claim 21, the claim recites "A computer instruction signal embodied in a carrier wave carrying instructions...". A carrier wave is not deemed a tangible computer readable medium. As such, the claim is not limited to statutory subject matter and is therefore non-statutory. Dependent claims 22-27 depend on claim 21 and therefore are rejected under the same rationale.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-9, 12-17, 19-22 and 25-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama (US 6,333,790 B1) in view of Engel et al. (US 2002/0198969 A1), hereinafter referred to as Engel.

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5. Regarding claim 1, Kageyama teaches the downloading of configuration information including user-specified information in the form of program updates for a printer device (col. 15, ll. 33-39) and the installation of downloaded information to configure printer devices (col. 16, ll. 36-41) but does not explicitly teach the utilization of a configuration plug-in. However, in related art, Engel teaches on the use of the configuration of network devices utilizing an applet (page 1, paragraph 0008), which is deemed functionally equivalent to the software plug-in claimed. One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize a plug-in to perform a step of retrieving information on a network. One of ordinary skill in the art would have been motivated to combine teachings of Engel with Kageyama as taught by Engel wherein the use of an applet reduces cost of device configuration (Engel, page 1, paragraph 0007).

6. Regarding claim 2, Kageyama and Engel teach the method wherein the configuration plug-in and configuration data include data prepared by:

determining a make and model for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information); and

determining user thresholds for consumables associated with the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; use information).

7. Regarding claim 3, Kageyama and Engel teach the method wherein downloading includes:

sending an electronic message via the Internet to a website for a vendor associated with the hard copy output engine (Kageyama, col. 11, ll. 48-59); and

receiving an electronic message via the Internet in response to sending
(Kageyama, col. 11, ll. 48-59).

8. Regarding claim 5, Kageyama and Engel teach the method wherein configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed (Kageyama, col. 6, ll. 5-11).

9. Regarding claims 6, Kageyama and Engel teach the method wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (Kageyama, col. 5, ll. 58-61).

10. Regarding claims 7, Kageyama and Engel teach the method wherein the configuration plug-in and configuration data include data prepared by:

determining a make and model for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information);

determining a serial number for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information); and

determining user thresholds for consumables associated with the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; use information).

11. Regarding claim 8, Kageyama teaches the downloading of configuration information including user-specified information in the form of program updates for a printer device (col. 15, ll. 33-39) and the installation of downloaded information to configure printer devices (col. 16, ll. 36-41) but does not explicitly teach the utilization of a configuration plug-in. However, in related art, Engel teaches on the use of the

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configuration of network devices utilizing an applet (page 1, paragraph 0008), which is deemed functionally equivalent to the software plug-in claimed. One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize a plug-in to perform a step of retrieving information on a network. One of ordinary skill in the art would have been motivated to combine teachings of Engel with Kageyama as taught by Engel wherein the use of an applet reduces cost of device configuration (page 1, paragraph 0007).

12. Regarding claim 9, Kageyama and Engel teach the article of manufacture wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to:

determining a make and model for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information); and

determining user thresholds for consumables associated with the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; use information).

13. Regarding claim 12, Kageyama and Engel teach the article of manufacture wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to configure the hard copy output engine using the downloaded data to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed (Kageyama, col. 6, ll. 5-11).

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14. Regarding claims 13, Kageyama and Engel teach the article of manufacture wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to configure a hard copy output engine chosen from a group consisting of: facsimile machines, photocopiers and printers (Kageyama, col. 5, ll. 58-61).

15. Regarding claim 14, Kageyama and Engel teach the article of manufacture wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to:

determining a make and model for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information);

determining a serial number for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information); and

determining user thresholds for consumables associated with the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; use information).

16. Regarding claim 15, Kageyama teaches the downloading of configuration information including user-specified information in the form of program updates for a printer device (col. 15, ll. 33-39) and the installation of downloaded information to configure printer devices (col. 16, ll. 36-41) but does not explicitly teach the utilization of a configuration plug-in. However, in related art, Engel teaches on the use of the configuration of network devices utilizing an applet (page 1, paragraph 0008), which is deemed functionally equivalent to the software plug-in claimed. One of ordinary skill in

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the art at the time of the applicant's invention would have found it obvious to utilize a plug-in to perform a step of retrieving information on a network. One of ordinary skill in the art would have been motivated to combine teachings of Engel with Kageyama as taught by Engel wherein the use of an applet reduces cost of device configuration (Engel, page 1, paragraph 0007).

17. Regarding claim 16, Kageyama and Engel teach the computer implemented control system wherein the processing circuitry configured to employ the software module further comprises processing circuitry configured to employ the software module to:

determining a make and model for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information); and

determining user thresholds for consumables associated with the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; use information).

18. Regarding claim 17, Kageyama and Engel teach the computer implemented control system wherein the processing circuitry configured to employ the software module to configure includes processing circuitry configured to employ the software module to configure the hard copy output engine using the downloaded data to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed (Kageyama, col. 6, ll. 5-11).

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19. Regarding claim 19, Kageyama and Engel teach the computer implemented control system wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (Kageyama, col. 5, ll. 58-61).

20. Regarding claim 20, Kageyama and Engel teach the computer implemented control system wherein the processing circuitry configured to employ the software module further comprises processing circuitry configured to employ the software module to:

determine a make and model for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information);

determine a serial number for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information); and

determine user thresholds for consumables associated with the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; use information).

21. Regarding claim 21, Kageyama teaches the downloading of configuration information including user-specified information in the form of program updates for a printer device (col. 15, ll. 33-39) and the installation of downloaded information to configure printer devices (col. 16, ll. 36-41) but does not explicitly teach the utilization of a configuration plug-in. However, in related art, Engel teaches on the use of the configuration of network devices utilizing an applet (page 1, paragraph 0008), which is deemed functionally equivalent to the software plug-in claimed. One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize a plug-in to perform a step of retrieving information on a network. One of ordinary skill in

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the art would have been motivated to combine teachings of Engel with Kageyama as taught by Engel wherein the use of an applet reduces cost of device configuration (Engel, page 1, paragraph 0007).

22. Regarding claim 22, Kageyama and Engel teach the computer instruction signal wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure the hard copy output engine includes a computer instruction signal carrying instructions that when executed cause the processor to::

determining a make and model for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information); and

determining user thresholds for consumables associated with the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; use information).

23. Regarding claim 25, Kageyama and Engel teach the computer instruction signal wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure the hard copy output engine includes a computer instruction signal carrying instructions that when executed cause the processor to configure the hard copy output engine using the downloaded data to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed (Kageyama, col. 6, ll. 5-11).

24. Regarding claim 26, Kageyama and Engel teach the computer instruction signal wherein the computer instruction signal embodied in the carrier wave carrying

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instructions that cause the processor to configure the hard copy output engine includes a computer instruction signal carrying instructions that when executed cause the processor to configure a hard copy output engine chosen from a group consisting of: facsimile machines, photocopiers and printers (Kageyama, col. 5, ll. 58-61).

25. Regarding claim 27, Kageyama and Engel teach the computer instruction signal wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure the hard copy output engine includes a computer instruction signal carrying instructions that when executed cause the processor to:

determine a make and model for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information);

determine a serial number for the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; printer operation information); and

determine user thresholds for consumables associated with the hard copy output engine (Kageyama, col. 5, l. 66 – col. 6, l. 11; use information).

26. Regarding claim 28, Kageyama and Engel teach the method wherein the downloading comprising downloading a value, and the configuring comprises setting a threshold for a consumable associated with the hard copy output engine using the value (Kageyama, col. 16, ll. 36-41).

27. Regarding claim 29, Kageyama and Engel teach the method wherein the downloading comprising downloading a threshold for replenishment of a consumable associated with the hard copy output engine (Kageyama, col. 16, ll. 36-41).

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28. Regarding claim 30, Kageyama and Engel teach the method wherein the configuring comprises setting the threshold of the hard copy output engine (Kageyama, col. 16, ll. 36-41).

29. Regarding claim 31, Kageyama and Engel teach the method further comprising:
providing the user-specified information from a user (Kageyama, col. 5, l. 66 – col. 6, l. 11); and

generating at least one of the configuration plug-in and configuration data using the user-specified information before the downloading (col. 15, ll. 33-39).

30. Regarding claim 32, Kageyama and Engel teach the method wherein the configuring comprises altering the hard copy output engine (Kageyama, col. 16, ll. 36-41).

31. Regarding claim 33, Kageyama and Engel teach the method wherein the configuring comprises altering an operation of the hard copy output engine with respect to formation of hard images upon paper (Kageyama, col. 16, ll. 36-41).

32. Regarding claim 34, Kageyama and Engel teach the computer implemented control system wherein the processing circuitry is configured to employ the software module to set a threshold for replenishment of a consumable associated with the hard copy output engine to configure the hard copy output engine (Kageyama, col. 16, ll. 36-41).

33. Regarding claim 35, Kageyama and Engel teach the computer implemented control system wherein the processing circuitry is configured to employ the software

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module to configure the hard copy output engine comprising altering the hard copy output engine (Kageyama, col. 16, ll. 36-41).

34. Regarding claim 36, Kageyama and Engel teach the computer implemented control system wherein the processing circuitry is configured to employ the software module to configure the hard copy output engine comprising altering an operation of the hard copy output engine with respect to formation of hard images upon paper (Kageyama, col. 16, ll. 36-41).

35. Claims 4, 10, 11, 18, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama and Engel in view of Uchida et al. (U.S. 6,317,570), hereinafter referred to as Uchida.

36. Regarding claim 4, the combination of Kageyama and Engel teaches the method of sending an electronic message via the Internet to a vendor associated with the hard copy output engine and receiving an electronic message via the Internet in response to sending (Kageyama, col. 11, ll. 48-59) but does not explicitly teach wherein the sending and receiving include transmission across a firewall. However in related prior art, Uchida teaches a method for a user and a service center for the peripherals to establish communication via the Internet and have it secured by use of a firewall (see Fig. 1, Fig. 2, col. 3, lines 3-35). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize the use of a firewall as disclosed in the method of communication utilized by Uchida in order to achieve the desired level of security and protection a firewall offers (Uchida, col. 3, lines 3-4 and 30-32). It is for this that one of ordinary skill in the art would have been motivated to modify and improve the

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communication method taught by Kageyama and Engel to represent the more secure communication via the Internet method disclosed by Uchida.

37. Regarding claim 10, the combination of Kageyama and Engel teaches the article of manufacture of sending a first electronic message via the Internet to a vendor associated with the hard copy output engine and receiving a second electronic message via the Internet in response to sending (Kageyama, col. 11, ll. 48-59) but does not explicitly teach wherein the sending and receiving include transmission across a firewall. However in related prior art, Uchida teaches a method for a user and a service center for the peripherals to establish communication via the Internet and have it secured by use of a firewall (see Fig. 1, Fig. 2, col. 3, lines 3-35). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize the use of a firewall as disclosed in the method of communication utilized by Uchida in order to achieve the desired level of security and protection a firewall offers (Uchida, col. 3, lines 3-4 and 30-32). It is for this that one of ordinary skill in the art would have been motivated to modify and improve the communication method taught by Kageyama and Engel to represent the more secure communication via the Internet method disclosed by Uchida.

38. Regarding claim 11, the combination of Kageyama and Engel teaches the article of manufacture of sending a first electronic message via the Internet to a vendor associated with the hard copy output engine and receiving a second electronic message via the Internet in response to sending (Kageyama, col. 11, ll. 48-59) but does not explicitly teach wherein the sending and receiving include transmission across a

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firewall. However in related prior art, Uchida teaches a method for a user and a service center for the peripherals to establish communication via the Internet and have it secured by use of a firewall (see Fig. 1, Fig. 2, col. 3, lines 3-35). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize the use of a firewall as disclosed in the method of communication utilized by Uchida in order to achieve the desired level of security and protection a firewall offers (Uchida, col. 3, lines 3-4 and 30-32). It is for this that one of ordinary skill in the art would have been motivated to modify and improve the communication method taught by Kageyama and Engel to represent the more secure communication via the Internet method disclosed by Uchida.

39. Regarding claim 18, the combination of Kageyama and Engel teaches the computer implemented control system of sending a first electronic message via the Internet to a vendor associated with the hard copy output engine and receiving a second electronic message via the Internet in response to sending (Kageyama, col. 11, ll. 48-59) but does not explicitly teach wherein the sending and receiving include transmission across a firewall. However in related prior art, Uchida teaches a method for a user and a service center for the peripherals to establish communication via the Internet and have it secured by use of a firewall (see Fig. 1, Fig. 2, col. 3, lines 3-35). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize the use of a firewall as disclosed in the method of communication utilized by Uchida in order to achieve the desired level of security and protection a firewall offers (Uchida, col. 3, lines 3-4 and 30-32). It is for this that one of ordinary skill

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in the art would have been motivated to modify and improve the communication method taught by Kageyama and Engel to represent the more secure communication via the Internet method disclosed by Uchida.

40. Regarding claim 23, the combination of Kageyama and Engel teaches the computer instruction signal which causes the processor to send a first electronic message via the Internet to a vendor associated with the hard copy output engine and receive a second electronic message via the Internet in response to the sending (Kageyama, col. 11, ll. 48-59) but does not explicitly teach wherein the sending and receiving include transmission across a firewall. However in related prior art, Uchida teaches a method for a user and a service center for the peripherals to establish communication via the Internet and have it secured by use of a firewall (see Fig. 1, Fig. 2, col. 3, lines 3-35). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize the use of a firewall as disclosed in the method of communication utilized by Uchida in order to achieve the desired level of security and protection a firewall offers (Uchida, col. 3, lines 3-4 and 30-32). It is for this that one of ordinary skill in the art would have been motivated to modify and improve the communication method taught by Kageyama and Engel to represent the more secure communication via the Internet method disclosed by Uchida.

41. Regarding claim 24, the combination of Kageyama and Engel teaches the computer instruction signal which causes the processor to send a first electronic message via the Internet to a vendor associated with the hard copy output engine and receive a second electronic message via the Internet in response to the sending

(Kageyama, col. 11, ll. 48-59) but does not explicitly teach wherein the sending and receiving include transmission across a firewall. However in related prior art, Uchida teaches a method for a user and a service center for the peripherals to establish communication via the Internet and have it secured by use of a firewall (see Fig. 1, Fig. 2, col. 3, lines 3-35). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize the use of a firewall as disclosed in the method of communication utilized by Uchida in order to achieve the desired level of security and protection a firewall offers (Uchida, col. 3, lines 3-4 and 30-32). It is for this that one of ordinary skill in the art would have been motivated to modify and improve the communication method taught by Kageyama and Engel to represent the more secure communication via the Internet method taught by Uchida.

(10) Response to Argument

A. Claims 1-36 under 35 USC 103 in view of Kageyama and Engel

1. Appellant argues that limitations of the claims are not disclosed nor suggested by the prior art and the Office has failed to meet its burden of establishing a prima facie 103 rejection for at least this reason. Specifically, the appellant argues with respect to independent claims 1, 8, 15 and 21 that Kageyama does not teach the claimed limitation of "downloading data including configuration data including user-specified information" (*emphasis added*). The examiner submits that the user specified information is being interpreted as information provided by a user in some capacity with respect to information about the user's printing device, or hard copy output engine, as recited in the claims. Kageyama teaches the providing of registration information and

printer operation information in column 5, line 66 through column 6, line 11 and figure 10, parts 10A and 10B, wherein the registration information includes the printer manufacturing number, the printer installation place, the printer type name and printer system construction/option and the printer operation information includes the period of use, number of trouble/failure occurrences and the trouble/failure history. The registration information taught by Kageyama teaches on the aspect of the claimed "user-specified information." Kageyama further provides the configuration data in column 15, lines 33-39, wherein Kageyama teaches the transmission of data through a network used to perform updating operations. The data used to perform updating is directly related to the user-specified information and therefore Kageyama is found to teach the limitation of "downloading data including configuration data including user-specified information" (*emphasis added*).

Appellant argues further that Engel does not teach the limitation of "downloading data including configuration data including user-specified information" (*emphasis added*) and therefore the combination set forth does not teach or suggest the claimed limitations. The examiner submits that the Kageyama teaches the claim limitation as set forth in the above paragraph and therefore the combination of Kageyama and Engel as set forth in the rejections above teach and suggest the positively claimed limitations of the claims.

B. Claims 1-14 and 21-33 under 35 USC 103 in view of Kageyama and Engel

2. Appellant argues with respect to independent claims 1, 8 and 21 that the applet of Engel includes "user-specified information" and further that the "applet which is

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downloaded is user-specified.” The examiner submits that the prior art teaches what is required by the claim. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Engel is not relied upon by the examiner to teach the claimed “user-specified information” as concluded by the appellant. Engel is merely relied upon for teaching the common use of a configuration plug-in in the form of an applet within the art. Kageyama is relied upon for teaching the user-specified information wherein Kageyama teaches the providing of registration information and printer operation information in column 5, line 66 through column 6, line 11 and figure 10, parts 10A and 10B, wherein the registration information includes the printer manufacturing number, the printer installation place, the printer type name and printer system construction/option and the printer operation information includes the period of use, number of trouble/failure occurrences and the trouble/failure history. The registration information taught by Kageyama teaches on the aspect of the claimed “user-specified information.”

C. Claims 1-36 under 35 USC 103

3. Appellant argues with respect to the rejection of the claims in view of Kageyama and Engel that the Office has failed to present an articulated reasoning with a sufficient rational underpinning to support the legal conclusion of obviousness. The examiner submits that to establish a prima facie case of obviousness, there must be

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some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The examiner submits and maintains that the requirement of providing a sufficient rational underpinning to support the legal conclusion of obviousness has been met. Engel provides on page 1, in paragraph 0008 the utilization of an applet to perform network device configuration steps. The applet taught by Engel is deemed functionally equivalent to the software plug-in claimed. The examiner maintains that the utilization of a plug-in to retrieve information within a networking environment is therefore concluded to be obvious. The utilization of a software plug-in as taught by Engel is found to reduce the cost of network device configuration because the need for specialized application programs for network device configuration is eliminated (see p. 1 of Engel, paragraphs 0007 and 0008).

D. Claims 2 and 7 under 35 USC 103 in view of Kageyama and Engel

4. Appellant argues with respect to dependent claims 2 and 7 that the prior art references, Kageyama and Engel, do not teach or suggest “determining a make and model for the hard copy output engine and determining user thresholds for consumables associated with the hard copy output engine” as claimed. The examiner submits that Kageyama teaches on these features of the claims. Kageyama sets forth a method in column 5, line 66 through col. 6, line 11 wherein a user’s device (e.g. a printer) is recorded as registration information. It is deemed inherent that this registration information would include specific information about a device and therefore obviously include a device’s make and/or model. In order to provide accurate

configuration information, the device's make and/or model is information that is deemed valuable for updating steps. It is also submitted by the examiner that Kageyama teaches on the "determining user thresholds for consumables associated with the hard copy output engine" wherein Kageyama teaches within the method in column 5, line 66 through column 6, line 11 the recording of a devices 'use information' and the 'operation information' with respect to a device.

E. Claims 9, 14, 16, 20, 22 and 27 under 35 USC 103 in view of Kageyama and Engel

5. Appellant argues with respect to dependent claims 9, 14, 16, 20, 22 and 27 that the prior art references, Kageyama and Engel, do not teach or suggest "determining user thresholds for consumables associated with the hard copy output engine" as claimed. The examiner submits that Kageyama teaches on these features of the claims. Kageyama sets forth a method in column 5, line 66 through col. 6, line 11 wherein a user's device (e.g. a printer) is recorded as registration information. It is also submitted by the examiner that Kageyama teaches on the "determining user thresholds for consumables associated with the hard copy output engine" wherein Kageyama teaches within the method in column 5, line 66 through column 6, line 11 the recording of a devices 'use information' and the 'operation information' with respect to a device.

F. Claims 5, 12, 17 and 25 under 35 USC 103 in view of Kageyama and Engel

6. Appellant argues with respect to dependent claims 5, 12, 17 and 25 that the prior art references, Kageyama and Engel, do not teach or suggest "to set a threshold

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for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed” as claimed. The examiner submits that Kageyama teaches on these features of the claims. Kageyama sets forth a method, in column 6, lines 5-11, of managing consumable articles as replaceable parts. Kageyama teaches the printer engine being managed with respect to paper, toner, photosensitive drum and cleaner etc. Kageyama therefore at least teaches the management of print media by way of monitoring use information as set forth in col. 5, line 66 through col. 6, line 11 wherein a user’s device (e.g. a printer) is monitored with respect to use information.

G. Claim 28 under 35 USC 103 in view of Kageyama and Engel

7. Appellant argues with respect to dependent claim 28 that the prior art references, Kageyama and Engel, do not teach or suggest “downloading a value, and the configuring comprises setting a threshold for a consumable associated with the hard copy output engine using the value” as claimed. The examiner submits that Kageyama teaches on these features of the claims. Kageyama sets forth a method, in column 6, lines 5-11, of managing consumable articles as replaceable parts. Kageyama teaches the printer engine being managed with respect to paper, toner, photosensitive drum and cleaner etc. Kageyama therefore at least teaches the management of print media by way of monitoring use information as set forth in col. 5, line 66 through col. 6, line 11 wherein a user’s device (e.g. a printer) is monitored with respect to use information. An individual printer can be managed with respect to its status. The status of a printer as

taught by Kageyama in column 6, lines 12-17 is found to be within the scope of monitoring a printer's threshold value.

H. Claims 29-30 under 35 USC 103 in view of Kageyama and Engel

8. Appellant argues with respect to dependent claims 29 and 30 that the prior art references, Kageyama and Engel, do not teach or suggest "downloading a threshold for replenishment of a consumable associated with the hard copy output engine" as claimed. The examiner submits that Kageyama teaches on these features of the claims. Kageyama sets forth a method, in column 6, lines 5-11, of managing consumable articles as replaceable parts. Kageyama teaches the printer engine being managed with respect monitoring use information as set forth in col. 5, line 66 through col. 6, line 11 wherein a user's device (e.g. a printer) is monitored with respect to use information. An individual printer can be managed with respect to its status. The status of a printer as taught by Kageyama in column 6, lines 12-17 is found to be within the scope of monitoring a printer's threshold value.

I. Claim 30 under 35 USC 103 in view of Kageyama and Engel

9. Appellant argues with respect to dependent claim 30 that the prior art references, Kageyama and Engel, do not teach or suggest "setting the threshold for replenishment of a consumable associated with the hard copy output engine" as claimed. The examiner submits that Kageyama teaches on these features of the claims. Kageyama sets forth a method, in column 6, lines 5-11, of managing consumable articles as replaceable parts. Kageyama teaches the printer engine being managed with respect monitoring use information as set forth in col. 5, line 66 through col. 6, line

11 wherein a user's device (e.g. a printer) is monitored with respect to use information. An individual printer can be managed with respect to its status. The status of a printer as taught by Kageyama in column 6, lines 12-17 is found to be within the scope of monitoring a printer's threshold value.

J. Claim 31 under 35 USC 103 in view of Kageyama and Engel

10. Appellant argues with respect to dependent claim 31 that Kageyama and Engel do not teach the claimed limitation of "providing the user-specified information from a user and generating at least one of the configuration plug-in and configuration data using the user-specified information before the download." The examiner submits that the user specified information is being interpreted as information provided by a user in some capacity with respect to information about the user's printing device, or hard copy output engine, as recited in the claims. Kageyama teaches the providing of registration information and printer operation information in column 5, line 66 through column 6, line 11 and figure 10, parts 10A and 10B, wherein the registration information includes the printer manufacturing number, the printer installation place, the printer type name and printer system construction/option and the printer operation information includes the period of use, number of trouble/failure occurrences and the trouble/failure history. The registration information taught by Kageyama teaches on the aspect of the claimed "user-specified information." Kageyama further provides the configuration data in column 15, lines 33-39, after the registration information is recorded, wherein Kageyama teaches the transmission of data through a network used to perform updating operations. The data used to perform updating is directly related to the user-

specified information and provided before the downloading of configuration information needed for the user's device and therefore Kageyama and Engel is found to teach the limitation of " providing the user-specified information from a user and generating at least one of the configuration plug-in and configuration data using the user-specified information before the download."

K. Claim 34 under 35 USC 103 in view of Kageyama and Engel

11. Appellant argues with respect to dependent claim 34 that the prior art references, Kageyama and Engel, do not teach or suggest "to employ the software module to set a threshold for replenishment of a consumable associated with the hard copy output engine to configure the hard copy output engine" as claimed. The examiner submits that Kageyama teaches on these features of the claims. Kageyama sets forth a method, in column 6, lines 5-11, of managing consumable articles as replaceable parts. Kageyama teaches the printer engine being managed with respect monitoring use information as set forth in col. 5, line 66 through col. 6, line 11 wherein a user's device (e.g. a printer) is monitored with respect to use information. An individual printer can be managed with respect to its status. The status of a printer as taught by Kageyama in column 6, lines 12-17 is found to be within the scope of monitoring a printer's threshold value.

L. Claims 21-27 under 35 USC 101

12. Appellant argues with respect to claims 21-27 that the 101 rejection is not supported by authority and denies them equal protection under the 14th amendment of the U.S. Constitution. The examiner asserts that the rejection is proper under the

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Interim Guidelines for the Examination of Patent Applications for Patent Subject Matter Eligibility, published on November 22, 2005 in the Federal Register. Accordingly, the Examiner is merely implementing the Director's policy with regard to this subject. As to the equal protection argument, the examiner asserts that the Director's position that carrier waves and signals are not eligible subject matter is consistent with the equal protection clause.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Benjamin A. Ailes

/B. A. A./

Examiner, Art Unit 2142

Conferees:

Andrew Caldwell

/Andrew Caldwell/
Supervisory Patent Examiner, Art Unit 2142

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Supervisory Patent Examiner, Art Unit 2145